

REMARKS

Summary

Claims 1-5, 8-12, and 21-34 were pending. Claims 29 and 30 have been allowed, and Claims 9-12, 25 and 26 were objected to. Claims 1-5, 8, 22-24, 27-28 and 31-34 were rejected. Claims 6, 7 and 13-20 had previously been withdrawn in response to a restriction requirement. Claims 4-5, 8, 11 and 22 have been amended; Claims 1-3, 9, 21, 23-28 and 31-34 have been cancelled; and new Claims 35-44 are presented. Claims 43 and 44 are generic to the elected and non-elected, and as they are allowable, the Applicants respectfully request that the election requirement be withdrawn. No new matter has been introduced. Claims 4-5, 8, 10-12, 22, 29-30, and 35-44 are pending after entry of this amendment.

Claim Rejections

35 U.S.C. § 112, first paragraph

Claims 1, 8, 22 and 31 were rejected under 35 U.S.C. § 112, first paragraph as not being enabled by the disclosure. Claims 1-5, 22-24, 27-28 and 31-34 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. These claims were presented in the present form in Applicants' amendment filed May 2, 2003, except that Claim 1 was further amended in the response of November 24, 2003 to add an additional restriction and new Claim 31 was directed to similar subject matter. The previously presented claims were not rejected on the grounds now asserted in the present Office Action (see Office Action of July 7, 2003). The Applicants respectfully traverse the rejections. A rejection on lack of enablement is warranted only when the specification fails to teach the claim rejected. Fig. 7 very clearly relates the claimed distance to either the Young's modulus or the atomic ratio of N in the film and the specification teaches manufacturing methods to achieve these specific values. Consequently, a person skilled in the art would be in no doubt as to how to achieve material properties so as to meet the

limitation of the claim. A similar argument can be made with respect to the written description rejections. However, the independent claims reciting a projection distance have been cancelled in order to expedite the prosecution of this application.

With regard to the Young's modulus of Ta₂O₅, the Examiner disputes the approximate quantity "about 5" percent, on the apparent basis that while the Young's modulus of SiON may have some variability, the Young's modulus of Ta₂O₅ is taken as a fixed value for purposes of computation. Since the Young's modulus of both compounds will have some variability either intrinsically or due to normal measurement tolerances, the choice of an exact relative percentage is inappropriate. However, as the invention is directed towards a SiO₂ or a SiON gap layer, the Applicants have chosen to cancel the claims related to Ta₂O₅, which were previously introduced by amendment.

The Examiner asserts that Claim 1 does not meet the written description requirement of 35 U.S.C. § 112, first paragraph. The purpose of the written description requirement is to ensure that the Applicants convey with reasonable clarity, to those skilled in the art, that they were in possession of the invention as of the filing date of the application. The manner in which the specification as filed meets the written description requirement is not material. The requirement may be met by either an express or an implicit disclosure. *In re Wertheim*, 541 F.2d 257, 262, 191 USPQ 90,96 (CCPA 1976). An invention claimed need not be described in *ipsis verbis* in order to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph. *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971).

The Applicants respectfully traverse the rejection based on lack of written description, calling the Examiner's attention, for example, to the specification at page 1, lines 5-13, page 2, lines 25-33, page 3 lines 4-8, and page 4, lines 19-20, which specifically address the subject matter found wanting by the Examiner.

However, as mentioned above, Claim 1 has been cancelled. Therefore, the rejections on enablement and written description under 35 U.S.C. § 112, first paragraph, are moot.

Allowed Subject Matter

The Examiner indicated at page 11 of the Office Action, that Claims 9-12, 25 and 26 were objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 29 and 30 were allowed.

Claim 8 has been amended to incorporate the subject matter of Claim 9, which has been cancelled. Claims 10-12 remain dependent on Claim 8, and are now allowable as claims dependent on an allowable base claim.

Claims 25 and 26 are cancelled, as the base claim upon which they are dependent has been cancelled.

New Claims 35-42 are presented, further describing the invention, and either containing subject matter that the Examiner has indicated as being allowable, or being dependent on such claims.

Generic Claims

New Claims 43 and 44 are presented. These claims are generic to, for example, Claims 29 and 6, and Claims 8 and 13, respectively. On the presentation of an allowable generic claim, the Applicant is entitled to examination of the generic claim and non-elected species addressed by the generic claim. 37 CFR § 1.141 (a).

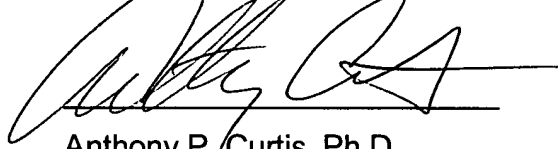
Conclusion

Claims 4-5, 8, 11 and 22 have been amended; Claims 1-3, 9, 21, 23-28 and 31-35 have been cancelled; and new Claims 36-46 are presented. Claims 4-5, 8, 10-12, 22, 29-30, and 35-44 are pending.

For at least the reasons given above, the Applicants respectfully submit that the pending claims are allowable, and that the claims drawn to the non-elected species should be allowed as well.

The Examiner is respectfully requested to contact the undersigned in the event that a telephone interview would expedite consideration of the application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', written over a horizontal line.

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